

REMARKS

The present response amends the specification and claims 1, 15-18, 21, 23-25, 27, 31, 33, and 36. Claims 14, 20, 26, and 32 have been canceled. Claims 1-13, 15-19, 21-25, 27-31, and 33-37 remain pending in the captioned case. Further examination and reconsideration of the presently claimed application are respectfully requested.

Objections to the Specification

An objection was lodged for the use of trademarks in the application. In response thereto, Applicant has canceled the objectionable language.

Section 112 Rejection

Claims 2-17, 20-24, 26-29, and 32-37 were rejected under 35 U.S.C. § 112, second paragraph. With regard to claims 2-17, the preambles have been amended in a consistent manner. With regard to claim 20, 26, and 32, the term “all buyers” has been amended to correct the antecedent basis. With regard to claim 23 and 36, Applicant agrees that the limitations do not invoke § 112(6). With regard to claim 24, the objectionable term has been deleted. With regard to claim 34, the antecedent basis has been amended. Accordingly, Applicants respectfully request removal of this rejection.

Section 101 Rejection

Claims 1-17 were rejected under 35 U.S.C. § 101 as allegedly reciting steps that do not contain sufficient computer structure that are within “technological arts.” (Office Action, pg. 5.) In response thereto, claim 1 has been amended to recite a computer database. The computer database contains information which, when consulted, allows determination of an inventory status of a product being considered for purchase. Applicant believes amendment to claim 1 addresses the concerns raised in this rejection. As noted in MPEP 2106(i), present claim 1 is a method claim and “such claims should be treated like any other process claims, pursuant to these Guidelines when relevant.” *In re Toma* 575 F.2d 872 (CCPA 1978). More specifically, MPEP 2106(iv)(b) defines the Guidelines in which method claims are deemed appropriate under 35 U.S.C. § 101. Present claim 1 fulfills the “safe harbor” requirement of MPEP 2106 as containing a database in which process activity takes place on that database as part of the

step of determining an inventory status and informing the buyer of a change therein. Accordingly, Applicant respectfully requests removal of this rejection.

Section 102 Rejection

Claims 1-6, 11, 18-20, 25, and 30-32 were rejected under 35 U.S.C. § 102(b) as being anticipated by the “TV and Radio Meet the Internet, Part Deux: Inter casting” article (hereinafter “the Article”). The standard for “anticipation” is one of fairly strict identity. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art of reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP 2131. Furthermore, anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, as arranged in the claim. *W.L. Gore & Assocs. V. Garlock*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983). Using these standards, Applicants submit the cited art fails to disclose each and every element of the currently pending claims, some distinctive features of which are set forth in more detail below.

The Article does not teach or suggest comparing an inventory quantity of a product to an aggregate quantity of the product either contained in an electronic shopping cart or considered for purchase by a plurality of all buyers. Present claims 1, 18, and 31 have been amended to include the aforementioned subject matter. The amendment of claim 1 was taken from claim 14, the amendment of claim 18 was taken from claim 20, and the amendment of claim 31 was taken from claim 32. Accordingly, these amendments do not present new subject matter.

While the Article describes sending catalog previews of goods to be sold as well as remaining inventory countdowns, the Article does not suggest in any way comparing the inventory quantity to anything, much less comparing it to an aggregate quantity of a product within a shopping cart of considered for purchase by a buyer. Absent any suggestion of a quantity of a product being considered for purchase by buyers, either through a shopping cart or otherwise, Applicant can see no relevance in the Article describing simply an inventory of goods or a remaining inventory countdown of such goods.

The Article does not teach or disclose notification instructions that generate a notification quantity value by applying a conversion rate factor to an inventory quantity, and thereafter informing a buyer if the notification quantity value is equal to or greater than an aggregate quantity

of the product currently being considered for purchase. Present claim 25 contains the aforementioned description that is nowhere shown, taught, or alluded to whatsoever in the Article. Not only does the Article fail to suggest an aggregate quantity of a product being considered for purchase, but also it fails to make any mention of setting a notification quantity value based on a conversion rate.

For at least the reasons stated above, Applicant asserts that independent claims 1, 18, 25, and 31, as well as claims dependent therefrom, are not anticipated by the cited art. Accordingly, Applicant respectfully requests removal of this rejection.

Section 103 Rejection

Claims 7-10, 12-17, 21-24, 26-29, and 33-37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Article. In essence it appears the Office Action notes that the Article can be combined with Official Notice taken by the Examiner. Applicant disagrees. For example, the Office Action contends that, based on the Article, determination of when notification is to be made is well known. (Office Action, pg. 7.) Absent any suggestion whatsoever in the Article, Applicant can find no reason why determination of when notification can be made. The Article makes no mention whatsoever of comparing an inventory quantity to an aggregate quantity as set forth in many of the independent claims, much less using that comparison in order to inform a prospective buyer of when he or she should buy, as set forth in many dependent claims (e.g., claims 15-17, 21-24, 27-29, and 33-34). There must be some suggestion or motivation in the Article in order for this rejection to be sustained. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (C.C.P.A 1974); MPEP 2143.03.

In addition to the Office Action failing to meet the standard for establishing a *prima facie* case of obviousness, the foundation in which the obviousness rejection is made is also flawed. As set forth in MPEP 2144.03, “when a rejection is based on facts within the personal knowledge of the Examiner, the data should be stated as specifically as possible, and the facts must be supported, when called for by the Applicant, by an affidavit from the Examiner.” Applicant hereby traverses any suggestion or assertion made by the Examiner that the subject matter contained in the present independent claims and lacking from the Article, is somehow well known. Therefore, Applicant asserts that the Official Notice taken by the Examiner is improper. Once an Applicant traverses an assertion made the Examiner, either the Examiner must “cite a reference in support of his or her position” or provide the requested affidavit. Accordingly, a demand is hereby made for evidence to support the Examiner’s position. *In re Chevenard*, 139 F.2d 71

(CCPA 1943). In fact, "assertions of technical facts in areas of esoteric technology must always be supported by citation of some reference work." (*See In re Ahlert*, 424 F.2d 1088 (CCPA 1970).) Applicant asserts that notification of when to inform a prospective buyer based on the present technology is "esoteric" and, therefore, any obviousness rejection thereto must be supported by cited art. The Office Action on its face fails to do so.

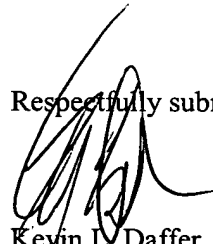
For reasons set forth above, Applicant traverses this rejection in its entirety along with any statements that the missing information from the Article would be well known to a skilled artisan.

CONCLUSION

The present amendment and response is believed to be a complete response to the issues raised in the Office Action mailed July 2, 2003. In view of the remarks traversing the rejections, Applicants assert that pending claims 1-13, 15-19, 21-25, 27-31, and 33-37 are in condition for allowance. If the Examiner has any questions, comments or suggestions, the undersigned attorney earnestly requests a telephone conference.

No fees are required for filing this amendment; however, the Commissioner is authorized to charge any additional fees which may be required, or credit any overpayment, to Conley Rose, P.C. Deposit Account No. 03-2769/5468-05900.

Respectfully submitted,



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Date: October 1, 2003